

B. REMARKS

In this reply, Claims 1, 4, 5, 13-16, 19, 21, 24-28, 32, 40-43, 48, 49, 57-60, 63, 65, 68-70 and 72-76 have been amended. Hence, Claims 1-76 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability. All issues raised in the Final Office Action mailed on February 11, 2005 are addressed hereinafter.

**REQUEST FOR RECONSIDERATION AND WITHDRAWAL OF FINALITY OF
OFFICE ACTION MAILED ON FEBRUARY 11, 2005**

The Final Office Action mailed on February 11, 2005 is the first Office Action after the filing of the Request for Continued Examination (RCE) on January 18, 2005. MPEP § 706.07(h) states that the first Office Action after filing an RCE may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first Office Action final in a continuing application are satisfied. MPEP § 706.07(b) requires that all claims in the new application be drawn to the same invention claimed in the earlier application. In the present situation, all claims as amended in the RCE would have to be drawn to the same invention as the claims prior to being amended in the RCE. The RCE filed on January 18, 2005 was accompanied by an amendment that amended all of the independent Claims 1, 19 and 26-28. The amendments to the claims were not merely directed to matters of form, e.g., to correct antecedent basis. It is therefore respectfully submitted that the claims as amended in the RCE are not drawn to the same invention as the claims prior to being amended in the RCE and all the conditions set forth in MPEP § 706.07(b) are not satisfied. Reconsideration and withdrawal of the finality of the Office Action mailed on February 11, 2005 is respectfully requested.

REJECTION OF CLAIMS 1-12, 14-39, 41-56 AND 58-76 UNDER 35 U.S.C. § 102(e)

In the Final Office Action, Claims 1-12, 14-39, 41-56 and 58-76 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Blumberg et al.*, U.S. Patent Application Publication No. US 2003/0140315 A1 (hereinafter “*Blumberg*”). It is respectfully submitted that Claims 1-12, 14-39, 41-56 and 58-76, as amended, are patentable over *Blumberg* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1, as amended, recites a method for previewing an electronic document that requires:

“generating the electronic document at a client;
transmitting document information associated with the electronic document from the client over a communications network to a printing device having a print process executing thereon for generating hard-copy printouts of electronic documents at the printing device;
the printing device generating preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client;
the printing device transmitting the preview document data to the client; and
previewing the electronic document at the client based on the preview document data received from the printing device.”

Claim 1 requires that a printing device generate preview document data and provide the preview document data to a client, where it is previewed. In particular, Claim 1 requires that the printing device have “a print process executing thereon for generating hard-copy printouts of electronic documents at the printing device” and that the printing device generate “preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client.” It is respectfully submitted that *Blumberg* does not

teach or suggest a method for previewing an electronic document that includes a printing device with these limitations.

Blumberg describes virtual builder software that allows a user to preview an electronic document with user-selected finishing options. The virtual builder software “can reside on client computers or server computers, or preferably both.” Blumberg at paragraph 0060, lines 2-3. Blumberg does not teach or suggest that the virtual builder software can reside on a printing device. As for on-demand print server 210 being a printing device, this issue was fully addressed in the remarks accompanying the Request for Continued Examination (RCE) filed on January 18, 2005. Specifically, on-demand print server 210 is described in *Blumberg* in the context of a conventional server for managing documents, without any printing capabilities. Furthermore, Blumberg does not teach or suggest that on-demand print server 210 includes a “print process for generating hard-copy printouts of electronic documents,” as required by Claim 1.

The only printing devices in Blumberg are local printer 260 and printing devices located at the corporate reproduction center 280. Blumberg does not in any way teach or suggest that local printer 260 or printing devices located at the corporate reproduction center 280 may be configured to generate preview document data and provide the preview document data to a client, as recited in Claim 1.

In view of the foregoing, it is respectfully submitted that the method for previewing an electronic document that includes the use of a printing device to generate preview document data as recited in amended Claim 1, is not taught or suggested by *Blumberg* and that Claim 1 is therefore patentable over *Blumberg*.

The Final Office Action mailed on February 11, 2005 included a “Response to Arguments” section that asserted “[i]n other words, the entire system of Blumberg is the

‘printing device’ and all of its parts are part of a ‘print process’ that generates hard-copy printouts of electronic documents.” It is respectfully submitted that this is not a reasonable interpretation of *Blumberg*. The system of *Blumberg* is a corporate intranet 200 that includes an electronic document management system 250, a corporate reproduction center 280, a Web server 290, an on-demand print server 210, a document authoring tool 240, a corporate user Web interface 230. Given the disclosed elements of corporate intranet 200 and that corporate intranet also includes a local printer 260, it is not a reasonable interpretation of *Blumberg* to construe the corporate intranet 200 as a printing device.

CLAIMS 2-12 AND 14-18

Claims 2-12 and 14-18 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-12 and 14-18 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-12 and 14-18 recite additional limitations that independently render them patentable over *Blumberg*.

CLAIM 19

Claim 19 is directed to a method for previewing an electronic document that requires a printing device that includes “a print process executing thereon for generating hard-copy printouts of electronic documents at the printing device.” Claim 19 also requires that the printing device generate “preview document data based on the document information and a set of one or more specific characteristics associated with the printing device.” As set forth herein with respect to Claim 1, *Blumberg* does not teach or suggest a method for previewing an electronic document that includes the use of a printing device to generate preview document data. It is

therefore respectfully submitted that Claim 19 includes one or more limitations that are not in any way taught or suggested by *Blumberg* and is therefore patentable over *Blumberg*.

CLAIMS 20-25

Claims 20-25 all depend from Claim 19 and include all of the limitations of Claim 19. It is therefore respectfully submitted that Claims 20-25 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 19.

CLAIMS 26-28

Claims 26-28 recite limitations similar to Claim 1, except in the context of a computer-readable medium, a system and a document preview apparatus. It is therefore respectfully submitted that Claims 26-28 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1.

CLAIMS 29-39 AND 41-45

Claims 29-39 and 41-45 all depend from Claim 26 and include all of the limitations of Claim 26. It is therefore respectfully submitted that Claims 29-39 and 41-45 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 26.

CLAIMS 46-56 AND 58-62

Claims 46-56 and 58-62 all depend from Claim 27 and include all of the limitations of Claim 27. It is therefore respectfully submitted that Claims 46-56 and 58-62 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 27.

CLAIMS 63-69

Claims 63-69 recite limitations similar to Claims 19-25, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 63-69 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claims 19-25.

CLAIMS 70-76

Claims 70-76 recite limitations similar to Claims 19-25, except in the context of apparatuses. It is therefore respectfully submitted that Claims 70-76 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claims 19-25.

In view of the foregoing, it is respectfully submitted that Claims 1-12, 14-39, 41-56 and 58-76 are patentable over *Blumberg*.

REJECTION OF CLAIMS 13, 40 AND 57 UNDER 35 U.S.C. § 103(a)

Claims 13, 40 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando*, U.S. Patent No. 6,449,053. It is respectfully submitted that Claims 13, 40 and 57 are patentable over *Blumberg* and *Bando*, alone or in combination, for at least the reasons provided hereinafter.

Claim 13 depends from Claim 1 and includes all of the limitations of Claim 1. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Blumberg*. These limitations are also recited in Claim 13. In the Advisory Action, the Examiner noted that *Bando* is not relied upon for teaching the Claim 1 limitation of generating preview document data at the printing device. Applicant agrees that *Bando* does not teach or suggest this limitation. Accordingly, given the arguments provided herein that Claim 1, as amended, recites one or more limitations not taught or suggested by *Blumberg*, it is

respectfully submitted that Claim 13 also includes one or more limitations not taught or suggested by *Blumberg* or *Bando*, considered alone or in combination, and that Claim 13 is therefore patentable over *Blumberg* and *Bando*.

Claims 40 and 57 recite limitations similar to Claim 13, except in the context of a computer-readable medium and an apparatus, respectively. It is therefore respectfully submitted that Claims 40 and 57 are patentable over *Blumberg* and *Bando* for at least the reasons set forth herein with respect to Claim 13.

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Date: March 16, 2005

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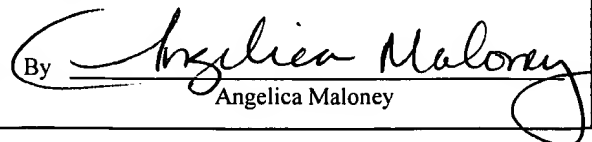
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop AF**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On March 16, 2005

By


Angelica Maloney